

## REMARKS

This application has been carefully reviewed in light of the Office Action dated July 15, 2004. Claims 1 to 45, 47, 48 and 85 are in the application, of which Claim 1 is still the only independent claim. Reconsideration and further examination are respectfully requested.

Claims 1 to 36 were rejected provisionally for obviousness-type double patenting over Claims 1 to 3, 6, 8 and 10 to 36 of co-pending Application No. 09/923,993 (hereinafter the “‘993 application”). In response, independent Claim 1 has been amended so as to emphasize the fluorescent activity of the presently claimed ink, in keeping with the subject matter of the non-rejected dependent claims (such as dependent Claim 47). Withdrawal of the rejection is therefore respectfully requested.

Moreover, since this double patenting rejection had been entered “provisionally”, it is respectfully requested for the Examiner to re-visit the claims of the ‘993 application, since those claims might have been changed or amended since the time when the double patenting rejection was first entered. In this regard, it is understood that the issue fee for the ‘993 application has been paid, such that it is possible that a patent on the ‘993 application might issue by the time that the Examiner next takes the subject application up for action.

Page 3 of the Office Action entered a requirement for a showing of common ownership with the ‘993 application, or to “name the prior inventor of the conflicting subject matter”, upon pain of abandonment for failure to do so. It is believed that this requirement was entered pursuant to the MPEP’s form paragraph 8.28 and 8.28.01 (found on page 800-36 of the May, 2004 Revision to MPEP). It is believed that this requirement was entered improvidently, since form paragraph 8.28 would require an earlier filing date

for the co-pending application. In fact, page 3 of the Office Action incorrectly states that the '993 application "would form the basis for a rejection of the noted claims under 35 U.S.C. § 103(a)", which is incorrect since the '993 application and the subject application have exactly the same filing date (August 8, 2001). Accordingly, no statement is being made, although Applicants are prepared to do so if one is still required. However, as stated above, it is believed that the requirement was entered improvidently and its withdrawal is respectfully requested.

Claims 23 and 43 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. In response, Claims 23 and 43 have been amended so that the language for those claims more closely tracks the language found in the originally-filed application (at pages 87 and 54, respectively). It should be understood that these claims are directed to the claimed ink composition, but amounts of constituent components thereof are adjusted based on calculations made with respect to ink compositions not within the claims. Reconsideration and withdrawal of the rejections are respectfully requested.

Claims 1 to 5, 7 to 15, 17 to 22, 24 to 26, 35, 36,, 38 to 45, 47 and 48 were rejected under 35 U.S.C. § 102(b) over U.S. Patent 5,865,883 (Teraoka), and Claims 6, 27 and 37 were rejected under § 103(a) over Teraoka; Claims 1 to 3, 7 to 21, 24 to 26, 39 to 42 and 48 were rejected under 35 U.S.C. § 102(b) over U.S. Patent 5,485,188 (Tochihara), and Claims 5, 6, 23, 35 and 36 were rejected under § 103(a) over Tochihara; and Claims 1 to 3, 5 to 7, 10, 12 to 15, 17 to 20, 24 to 26, 27 to 37, 39 to 42 and 44 were rejected under § 103(a) over U.S. Patent 6,176,908 (Bauer) in view of Teraoka<sup>1/</sup>. Reconsideration and withdrawal of the rejections are respectfully requested.

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<sup>1/</sup>Page 11 of the Office Action refers to "Tochihara", but it is believed that this is a clear typographic error in which "Bauer" was intended. The rejection has been treated as such, but clarification is respectfully requested if another meaning was intended.

The invention concerns an ink which shows fluorescence intensity when irradiated with ultraviolet light and uses compounds or coloring materials that exhibit fluorescent properties. The ink further includes first and second organic compounds that are incompatible with each other, as well as a liquid medium for dispersing the first and second compounds as well as the compound or coloring material.

By virtue of the foregoing arrangement, the presently claimed ink shows a noticeable fixing condition when fixed to a recording medium, which enables the ink to obtain an remarkably improved fluorescence intensity and colorfulness property. This can be seen clearly from the results of examples and comparative examples described in the specification. The Applicants herein believe that the high fluorescence of the present invention is obtained for the reasons described beginning on page 16 of the specification.

By contrast, even though it is true that Teraoka mentions a variety of compounds usable for coloring material or solvent, and Further describes fluorescent dyes and glycerol, it is also true that all of the inks according to Teraoka are intended for use under visible light. As a consequence, Teraoka does not at all mention or suggest the fluorescent intensity that arises due to excitation by ultraviolet light. Thus, it is believed that the properties of ink to be considered in Teraoka are completely different from those in the present invention.


Likewise, Tochiara also mentions a variety of compounds usable for coloring material or solvent, and describes fluorescent dyes and glycerol, but Tochiara indiscriminately uses fluorescent and non-fluorescent dyes and hence does not develop the concept of obtaining a high fluorescence intensity. As a matter of course, therefore, all of the inks according to Tochiara are intended to be used under visible lights, such that Tochiara does not disclose or suggest a fluorescence intensity that arises due to excitation by ultraviolet light.

Bauer has been studied, and although it is true that it describes an ink containing fluorescent dyes that is irradiated with ultraviolet light, Bauer does not disclose any of the ink compositions of the present invention. Moreover, it is Applicants' position that it is improper to combine Bauer with Teraoka, since the technical background of Bauer (fluorescent dyes irradiated with ultraviolet light) is completely different from that of Teraoka (dyes irradiated with visible light).

It is therefore respectfully submitted that the claims herein are neither anticipated by, nor would have been obvious from, any permissible combination of the applied art.

Applicants' undersigned attorney may be reached in our Costa Mesa office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

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